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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHANDLER, SARA M

ART UNIT

PAPER NUMBER

3693

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,570

Applicant(s)

TANINAKA ET AL.

Examiner

Sara Chandler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/26/05, 01/08/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 10/26/05 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicant failed to submit an english language translation of foreign references 08-193423, 09-034946 and 09-034939. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 4,5,6 and 7 are rejected under 35 U.S.C. 101. The claimed invention is directed to non-statutory subject matter. The claims are directed to a computer program with no medium.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitations "the upper limit" and "the actual repair cost" in line 3; and the limitation "the building owner" in line 4. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,3, 4, 6,8,9,10, 11, 13, 15,16,17,18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Makino, Japanese Pub. No. 08-193423.

Re Claims 1,8 and 15: Makino discloses a computer program/method/apparatus to: input at least one deterioration state parameter that quantitatively represents a deterioration state of constituents a building (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]); calculate future repair period and future repair cost for each constituent, based the deterioration state parameter (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]); and

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output the calculation results of said calculation unit at least in a tabular format (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]).

Re Claims 2,9 and 16: Makino discloses the computer program/method/apparatus, wherein said output outputs the calculation results in a graphic format (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]).

Re Claims 3,10 and 17: Makino discloses the computer program/method/apparatus, wherein the repair cost is guaranteed by a building management company as the upper limit of the actual repair cost to be actually paid by the building owner (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]).

Re Claims 4,11 and 18: Makino discloses a computer program/method/apparatus to: input at least one deterioration state parameter that quantitatively represents a deterioration state of constituents of a building (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]); calculate future management cost for each management job of the building, based on the deterioration state parameter (Makino, [0010] [0016] [0017]); and output the calculation results of said calculation unit at least in a tabular format (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]).

Re Claims 6, 13 and 20: Makino discloses a computer program/method/apparatus to:

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Input at least one deterioration state parameter that quantitatively represents a deterioration state of constituents of a building (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]); first calculate future repair period and future repair cost for each constituent, based on the deterioration state parameter (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]); output the calculation results of the first calculation at least in a tabular format (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]); second calculate future management cost for each management job of the building, based on the deterioration state parameter (Makino, [0010] [0016] [0017]); and output the calculations results of the second calculation at least in a tabular format (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]).

Claims 5,12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ida, Japanese Pub. No. 09-34939.

Re Claims 5,12 and 19: Kazuo discloses a computer program/method/apparatus to: collect at least light and fuel expenses data for each tenant of a building in a predetermined cycle (Ida, [0001] [0002] [0003] [0004]); calculate variable expenses for each tenant, based on the light and fuel expenses data (Ida, [0001] [0002] [0003] [0004]); and

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issue a bill describing an amount billed including at least variable expenses for each tenant (Ida, [0001] [0002] [0003] [0004]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7,14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino, Japanese Pub. No. 08-193423 in view of Ida, Japanese Pub. No. 09-34939.

Re Claims 7,14 and 21: Makino discloses a computer program/method/apparatus to: input at least one deterioration state parameter that quantitatively represents a deterioration state of constituents of a building (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]);

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first calculate future repair period and future repair cost for each constituent, based on the deterioration state parameter (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]);

output the calculation results of the first calculation at least in tabular format (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]);

second calculate future management cost for each management job of the building, based on the deterioration state parameter (Makino, [0010] [0016] [0017]);

output the calculation results of the second calculation at least in a tabular format (Makino, [0006] [0007] [0008] [0009] [0013] [0014] [0016] [0017] [0018] [0019] [0020] [0021] [0030] [0062] [0065] [0066]);

Makino fails to explicitly disclose a computer program/method/apparatus to:
collect at least light and fuel expenses data for each tenant of a building in a predetermined cycle;
calculate variable expenses for each tenant, based on the light and fuel expenses data;
and
issue a bill describing an amount billed including at least variable expenses for each tenant.

Ida discloses a computer program/method/apparatus to:
collect at least light and fuel expenses data for each tenant of a building in a predetermined cycle (Ida, [0001] [0002] [0003] [0004]);

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calculate variable expenses for each tenant, based on the light and fuel expenses data (lda, [0001] [0002] [0003] [0004]); and
issue a bill describing an amount billed including at least variable expenses for each tenant(lda, [0001] [0002] [0003] [0004]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Makino by adopting the teachings of lda to provide a computer program/method/apparatus to: input at least one deterioration state parameter that quantitatively represents a deterioration state of constituents of a building; first calculate future repair period and future repair cost for each constituent, based on the deterioration state parameter; output the calculation results of the first calculation at least in tabular format; second calculate future management cost for each management job of the building, based on the deterioration state parameter; output the calculation results of the second calculation at least in a tabular format; collect at least light and fuel expenses data for each tenant of a building in a predetermined cycle; calculate variable expenses for each tenant, based on the light and fuel expenses data; and issue a bill describing an amount billed including at least variable expenses for each tenant.

As suggested by lda one would have been motivated to provide tenants with knowledge about the various utility charged they are accruing so that they can manage and use the resources more wisely.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC


ELLA COLBERT
PRIMARY EXAMINER